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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,335	07/01/2004	David S. Bonalle	70655.3200	4334
20322	7590	05/09/2006	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 85004-2202			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/710,335		BONALLE ET AL.	
	Examiner		Art Unit	
	Daniel I. Walsh		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 13 February 2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-13, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer (US 2005/0232471) in view of Black (US 2005/0122209).

Baer teaches that a biometric data card can include different security levels by use of different biometric samples (paragraph [0037]). Though silent to notifying a user to proffer the sample, the Examiner notes that it is understood to be obvious to provide a user with instructions

to guide them, and that such notification and detection is an obvious expedient to one of ordinary skill in the art.

Baer is silent to the details of detecting and verifying the sample.

Black teaches detecting a proffered biometric at a sensor communicating the system to obtain a proffered biometric sample; verifying the proffered biometric sample, and authorizing a transaction (FIG. 1C). Re claim 4, Black teaches the step of detecting includes detecting a proffered biometric at a sensor configured to communicating with the system via at least one of a smartcard, reader, and network (FIG. 1C). Re claim 5, the Examiner notes that it is obvious that the step of detecting includes at least one of detecting, storing, and processing a proffered biometric sample (FIG. 1C). Re claim 6, the Examiner notes that a finite number of proffered biometrics is received during a transaction (for example, 1 fingerprint). Re claim 7, Black teaches that samples are logged/stored (transaction record paragraph [0126]). The Examiner also notes it's an obvious expedient to keep a log/record of transactions and associated data/information for record keeping purposes. Such logging/recording is conventional with credit card transactions where a signature is captured and stored in addition to credit card numbers, and therefore simply logging the biometric data, which is used for enhanced security, is an obvious expedient. Re claim 8, FIG. 1C teaches detecting/processing/storing at least one second proffered biometric sample (as both the electronic and digital signatures are captured). Re claim 9, FIG. 1C teaches comparing a proffered sample with a stored sample for verification. Re claim 10, Black teaches that a comparison between a proffered biometric sample and stored biometric samples includes comparing samples with a sample of at least one of a criminal, terrorist, and cardmember (FIG. 1C), as it is obvious that a proffered biometric is compared to

cardmembers to verify that the biometric matches the card member. Re claim 11, the Examiner notes that Black teaches embodiments where the biometric data can be stored on the portable device itself, or remotely (paragraph [0090] +). Accordingly, based upon the desired security, verifying the sample could either use information contained on at least one of a local database, remote database, and a third party controlled database. For example, in the case where the information is stored remotely, the Examiner notes it would have been an obvious expedient to store the information in a database, since databases are well known and conventional in the art, for storing and arranging data that can be fetched and accessed quickly and reliably. Therefore, storing the information on a database is an obvious expedient. Re claim 12, Black teaches the step of verifying includes verifying a proffered biometric sample using one of a local CPU and third party security vendor (FIG. 1C and claim which teaches a local processor/CPU verifying samples). Though Black in some embodiments is drawn to an RFID/transponder, the Examiner notes that Black states that such teachings can apply to smartcards as well (abstract). Re claim 13, a sensor has been discussed above re Black. Re claim 14,

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Baer. with those of Black.

One would have been motivated to do this to have a more secure means of authorizing a transaction that breaks a rule.

Though Baer/Black are silent to notifying a user to proffer a biometric sample (audibly/visually/mechanically/etc. re claim 3) the Examiner notes that it is well known and conventional to provide instructions/notifications to a user engaged in a card transaction, in order to guide them to facilitate completion of the transaction. This is especially well known and

conventional with standard credit card transactions where a user interfaces with a terminal that displays instructions to the user.

Re claim 16, the teaching of a transaction limitation being a maximum amount, has been discussed above, re claim 1.

Re claim 18, though silent to a government agency or vendor, Black above teaches remote storing of the sample. It would have been an obvious expedient to store at a government agency or vendor, to facilitate security of the stored samples.

4. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer/Black et al., as discussed above, in view of de Sylva (US 2005/0098621).

The teachings of Baer/Black have been discussed above.

Baer/Black are silent to a PIN in addition to a biometric, and facilitating selection of an account from two accounts.

The Examiner notes that the use of secondary security procedures, PIN, passcodes, etc. are obvious in the art to supplement security in a system. Along those lines, de Sylva teaches a PIN (paragraph [0030]) and facilitating selection of an account through account records 30, which selects accounts based on user preferences.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Baer/Black with those of de Sylva.

One would have been motivated to do this for additional security and for permitting user preferences to be involved in the transaction.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baer/Black, as discussed above, in view of Wallace (US 5,988,497).

The teachings of Baer/Black have been discussed above.

Baer/Black are silent to a second sample to override a transaction limitation.

Wallace teaches multiple tiers of authentication in order to authenticate a transaction that meets certain conditions (abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Baer/Black with those of Wallace.

One would have been motivated to do this to provide more authentication for certain transactions, as it is known that additional samples can provide more security. The replacing of additional PINs of Wallace, by biometrics of Black is an obvious expedient to provide more secure transactions.

Response to Arguments

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

The Examiner has cited the new art to Baer and Wallace, as discussed above, to teach preset transaction limitations (as set in the independent claims) and additional layers of security (re claim 17).

Additional Remarks

7. Janiak, as discussed in previous Office Actions, teaches requesting biometric data by a display to a user, to facilitate a transaction (see claim 45 of Janiak et al., for example), and Renner et al. teaches the use of a PIN (which Black replaces with a biometric) to force purchases of certain amounts to be checked with.

The Examiner notes that PINs associated with biometrics are well known and conventional for increased security (versus just a biometric; see US 2001/0029493, 5,764,789, 2004/0084524, 2002/0174067, 2002/0062284, 2001/0018660, which show that a PIN and biometric can be used together, for additional security over just a PIN or biometric, for example). The Examiner also notes Royer et al. (US 2004/0155101) teaches the use of different biometrics with multiple accounts and Ramachandran (US 2001/0013551) and Pitroda (US 6,925,439) which teach consolidation of card accounts onto one card for convenience and the selection of an account from a plurality of accounts.

The Examiner notes that different levels of security are well know and conventional in the art. For example, Deo et al. (US 5,721,781) teaches based on transaction amounts, different information is required in order to provide security/assurance that the user is valid (see Fig. 9), Rasmussen et al. (US 6,834,795) teaches similar teachings (FIG. 5), and Tetro et al. (US 6,095,413) teaches added security trough use of a separate databases).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh

Examiner

Art Unit 2876

5-3-06

A handwritten signature in black ink, appearing to be 'D. Walsh', written over the printed name and date.